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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/905,197

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Sami Nuutinen

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EXAMINER

TRINH, MINH N

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,197

Applicant(s)

NUUTINEN, SAMI

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: " An Apparatus for Mounting a Noise Suppression on a Printed Circuit Board".

2. The abstract of the disclosure should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is suggested that the last line: "(Figure2)" (abstract, line 15) should be deleted. Appropriate correction is required.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the associated features as cited in the claims such as: a power source; a circuit board; a plug in unit; an assembly head; etc. must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

a) The phrase: "and onto which holder"(claim 1, lines 6-7) should be changed to -
- for holding -. For better clarification of the claim languages.

b) The phrase "or the like" (claim 1, lines 9 and 12, claim 7, line 2) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

c) The scope of claim 1 is also not clear because the claims is clearly drawn to the suppressor unit as stated in the preamble, line 1 and the body of the claims somehow are link to the elements other than the claimed suppressor, for examples: the limitation recites "an assembly head" (see claim 1, lines 9-12), "through the common mode choke" (see claim 1, lines 17-18) these structures are not part of the suppressor unit.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9, as understood are rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al (US 5,307,041). Kato et al teach the claimed electrical device (suppressor unit) of the present invention comprising: a holder 1 having a bottom surface adapted for holding the common mode choke for the noise suppressor of the power source module is arranged, a lifting element 1h (see Fig. 3B); a surface mounting element 2 (see Fig. 5A), wherein the lifting element 1h (projection, Fig. 3B) is an elevation which projects substantially from the middle of the top surface of the holder 1 (see Figs. 1A, 3A and 5A); the bottom of the holder being substantially even as recited in claim 2 (see Figs. 1A and 3B); Kato et al inherently disclose that the mounting element such as pin being arranged in an opening of the holder as recited in claim 3 (see Fig. 3D pin 2 being arranged in the opening of the holder 1); at least one surface mounting element comprising a surface mounting foot as recited in claim 4 (see Fig. 3D, which shows the at least a surface mounting foot adapted to the associated power device); and the claimed subject matter as recited in claims 5-6 (see Fig. 3B-D which shows the at least one mounting foot 2B being partially embedded in the holder 1 and the bottom of the holder is substantially even and a mounting surface 2a being parallel to the holder).

Note that the limitation recites: "for installing and mounting a common mode choke for a noise suppressor . . . "(in the preamble); "for an assembly head "(claim 1, lines 9-12); etc., are functionally intended use. Further, the claimed invention must

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result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim (See *In re Casey*, 152 USPQ 235 (CCPA 1967)).

As applied to claims 7-9, see Kato's Fig. 3B, which shows the lifting element 1h having a grip surface being substantially even, and the holder and the lifting element are being parallel.

8. Claims 1-9, as understood are also rejected under 35 U.S.C. 102(b) as being anticipated by Kiesel et al (US 4,623,865). Kiesel et al anticipate the claimed apparatus of the present invention including: a holder or base 23 (see Fig. 1) having a bottom surface (bottom of 23), a lifting element 22, surface mounting element 25 and other elements therefrom which having the same shape and configuration as recited in each of claim 1-9 (see Fig. 1, references 23, 22, 25).

It is noted that the limitation recites: "for installing and mounting a common mode choke for a noise suppressor . . . "(in the preamble); "for an assembly head "(claim 1, lines 9-12); etc., are considered as functionally intended use because there is no structural difference between the claimed invention and the prior art reference. Therefore, the prior art structure is capable of performing the intended use.

Conclusion

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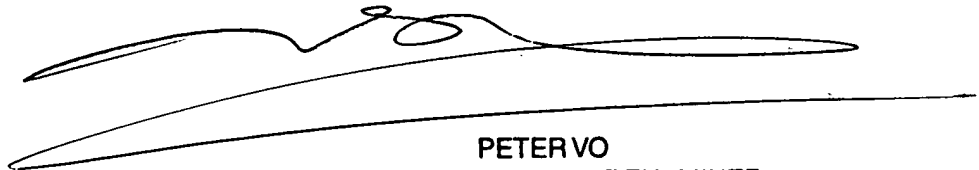
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of electrical surface mounting devices (ESMD).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

mt
August 12, 2003

A handwritten signature in dark ink, appearing to read 'Peter Vo', is written over a horizontal line.

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700